

**REMARKS**

With the entry of this Response, Claims 1-58 are pending in this application. With the entry of this Response, Applicants have amended Claims 3, 5, 7-15, 17, 20-21, 26, 28-33, 35-36, 38, 42-45, 47, 49-50, 53-55, and 58 to remove multiple dependencies and to address other claim formalities. Support for the amendments to these claims can be found in Applicants' specification as originally filed and in Applicants' claims as originally filed. Applicants do not believe that these amendments add new matter.

**RESTRICTION REQUIREMENT AND ELECTION OF SPECIES**

As recited below, the Office Action imposed a restriction requirement that restricted the claims into two groups.

**Group I** (Claims 1-16, 36-38, and 56-58) - drawn to nematocidal compositions and methods.

**Group II** (Claims 17-35 and 39-55) - drawn to compositions with excipients and methods of making them.

Applicants elect Group 2 (Claims 17-35 and 39-55) with traverse.

The Office Action also identified three separate types of species and required election of a single species. The Office Action stated that the "species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1." (Office Action, p. 4). The species are as follows:

**Species 1** – nematodes (Claims 1-58 are generic)

With respect to Species 1, Applicants elect "root-knot nematodes" (Claims 1-58) with traverse.

**Species 2** – terpene compounds (Claims 1-7 and 9-58 are generic)

With respect to Species 2, Applicants elect "thymol" (Claims 1-7 and 9-58 are generic) with traverse.

**Species 3** – excipient species (Claims 1-7, 36-38, and 56-58 are generic)

With respect to Species 3, Applicants have elected Group II (Claims 17-35 and 39-55) with traverse. As none of the claims of Species 3 fall within Applicants' elected group, Applicants are not required to elect a species of excipient.

37 C.F.R. § 1.475 provides that national stage applications shall relate to one invention or to a group of inventions so linked as to form a single general inventive concept. Such inventions possess unity of invention. The requirement of a single inventive concept is fulfilled when there is a technical relationship within the claimed subject matter involving one or more of the same or corresponding special technical features. The special technical feature must define a contribution that the claimed subject matter makes over the prior art.

As an initial point, Applicants note that neither the claims of Group I nor the claims of Group II are drawn to compositions. Rather, all of the claims are drawn to methods comprising a nematicidal composition. This limitation constitutes a special technical feature that defines a contribution that the claimed subject matter makes over the prior art. Thus, the pending claims all have the same corresponding technical feature. In making this Restriction Requirement, the Examiner has merely stated that the application contains groups of inventions that are not so linked as to form a single general inventive concept under PCT Rule 13.1. (Office Action, p. 2). But, the Examiner has provided no basis for this determination. Specifically, the Examiner stated:

The groups of inventions listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

(Office Action, p. 5). However, the Examiner never articulated any such reasons.

Applicants respectfully remind the Examiner that PCT Rule 13.2 states that:

the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Additionally, M.P.E.P. § 1850 states that contributions over the prior art “should be considered with respect to novelty and inventive step.” Applicants respectfully point out that the Examiner has not provided evidence that any disclosure exists in the art that would destroy the novelty or inventive step of this common technical feature and thereby destroy single the inventive concept. In fact, the Examiner has not recited any prior art in this Restriction Requirement. Thus, the

Examiner has not met his burden for establishing a lack of unity of invention. Accordingly, Applicants submit that all of the pending claims possess unity of invention.

37 C.F.R. § 1.475 discusses the determination of unity of invention. In particular, 37 C.F.R. § 1.475(b) states that “claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations [emphasis added].” The converse statement is not true. For instance, Rule 37 C.F.R. § 1.475(b) does not say that claims not falling within the listed categories requires or establishes a lack unity of invention. Rule 37 C.F.R. § 1.475(c) emphasizes this point, stating that “if an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.” (emphasis added). Again, the rule does not state that unity of invention would not exist, but rather that there was no guarantee it did exist. As noted above, the correct standard for determining unity of invention is stated in rule 37 C.F.R. § 1.475(a). This rule, as well as the Rule 37 C.F.R. § 1.475(b)-(c), are consistent with PCT Rule 13.2, which provides the exclusive standard for determining unity of invention in national stage applications.

Moreover, Applicants respectfully point out that the application provides only three independent claims. PCT Rule 13.4 states that:

it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention.

According to M.P.E.P. § 1850, “unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims.” (emphasis added). M.P.E.P. § 1850 states that “[i]f the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.”

To this end, Applicants note that the Examiner has restricted claims 17-35 into Group II. However, claims 17-35 are dependent upon independent claim 1, which is drawn to a method. Therefore, contrary to the Examiner’s statement that the claims of Group II are “drawn to COMPOSITIONS with EXCIPIENTS”, Applicants submit that claims 17-35 are drawn to

method of killing nematodes as claimed in independent claim 1. Because there are only three independent claims, all of which includes a special technical feature that defines a contribution over the prior art, and because all of the remaining claims possess this technical feature by virtue of their dependency on said independent claims, all the pending claims possess unity of invention. For this reason alone, Applicants submit that the Examiner's restriction is *prima facie* improper. Accordingly, Applicants respectfully request rejoinder and examination of all of the claims.

Regarding the species elections, Applicants respectfully point out that as discussed in 37 C.F.R. § 1.141(a), an application may claim a reasonable number of species within a claimed genus as long as at least one genus claim encompassing all of the species is patentable. The appropriate application of the 37 C.F.R. § 1.141 is aimed at situations where there are unreasonable numbers of species claimed. The present situation is not a situation in which a genus of compounds, for example, a set of 1000 different nucleic acid molecules as well as each of the encompassed species are separately being claimed. This would be an appropriate circumstance for application of the election of species requirement. Rather, Applicants have claimed in each genus a small number of species possibilities. Applicants are not required in the present application to elect a species when Applicants have not claimed an unreasonable number of species. Thus, when a genus claim is found to be patentable, Applicants understand that the remaining members of the reasonable number of species must be examined.

### **CONCLUSION**

The foregoing is a complete response to the Restriction Requirement mailed June 18, 2010. Applicants respectfully submit that at least Claims 1-58 are patentable. Early and favorable consideration is solicited. Applicants file this Response solely to facilitate prosecution. Applicants reserve the option of prosecuting the restricted claims at another time or requesting rejoinder of the restricted claims once allowable claims are found.

If the Examiner believes there are other issues that can be resolved by a telephone interview, or that there are informalities that remain in the application that may be corrected by the Examiner's amendment, then a telephone call to the undersigned attorney at (678) 420-9300 is respectfully solicited.

Applicants believe that no fee is due; however, Applicants authorize the Commissioner to charge to Deposit Account No. 14-0629 any fees that may be required.

Respectfully submitted,

/Rebecca C.E. McFadyen, Reg. No. 57,952/

Rebecca C.E. McFadyen, J.D., Ph.D.

Registration No. 57,952

BALLARD SPAHR LLP  
Customer Number 23859  
(678) 420-9300  
(678) 420-9301 (fax)